

REMARKS/ARGUMENTS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided, for acknowledgement of Applicant's Information Disclosure Statements by return of the FORM PTO-1449s, and for acknowledgement of Applicant's Claim for Priority and receipt of the certified copy of the priority document.

Upon entry of the above amendments, the Drawings, the Specification (*i.e.*, the Abstract), and claims 1-10 will have been amended. Claims 1-10 are currently pending. Applicant respectfully requests reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

In the Official Action, the Examiner has objected to Figures 7 and 10 of the drawings for being dark and illegible. Therefore, Applicant has amended Figures 7 and 10 to generally illustrate the features of the photographs (*i.e.*, original Figures 7 and 10). No new matter is believed to have been added. Accordingly, Applicant submits that the objection to the drawings is improper, and should be withdrawn.

In the Official Action, the Examiner objected to the Specification (*i.e.*, the Abstract) for containing more than 150 words. Therefore, Applicant has amended the abstract to comply with the recommended word count and to remove legal phraseology (where appropriate). Accordingly, the objection to the Specification is improper, and should be withdrawn.

In the Official Action, the Examiner has rejected claims 1, 3 and 7-10 under 35 U.S.C. § 102(b) as being anticipated by HIPPS (U.S. Patent No. 2,543,780).

Although Applicant does not necessarily agree with the Examiner's rejection of the claims on these grounds, Applicant has nevertheless amended independent claim 1 to more clearly obviate the above-noted grounds of rejection solely in order to expedite prosecution of the present application. In this regard, Applicant notes that HIPPS fails to teach or suggest the combination of elements as recited in claim 1. In particular, claim 1 sets forth a device for ligament reconstruction including, inter alia, a tip and body each having two parallel through-holes formed therein in juxtaposition, wherein the body is connected to an outer peripheral longitudinal extending surface of the tip.

Applicant submits that HIPPS lacks any disclosure of at least the above noted combination of elements.

In this regard, element 39 (*i.e.*, the tubes) of HIPPS, which the Examiner considers to be a body portion, passes through a bottom surface of element 40 (*i.e.*, the circular plates, which the Examiner considers to be a generally elliptical shape of the tip portion). In other words, element 39 (as disclosed in HIPPS) does not contact an outer surface of element 40. Thus, HIPPS does not disclose the body being connected to an outer peripheral longitudinally extending surface of the tip, as recited in claim 1. Accordingly, the rejection of claims 1, 3 and 7-10 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1, as well as claims 2-10, depending therefrom, these claims are not anticipated thereby. Further, all pending dependent claims recite additional features that further define the present invention over the prior art. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102 and allow all pending claims in the present application.

In the Official Action, the Examiner has rejected claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over HIPPS.

Applicant respectfully traverses the above noted rejections of claims 1-10 under 35 U.S.C. § 103(a).

Initially, Applicant notes that claims 1-10 are listed among the claims rejected under 35 U.S.C. § 103(a). However, the Examiner has not addressed their respective recitations of claims 1, 3 and 7-10 as they pertain to the rejection under 35 U.S.C. § 103(a). That is, it appears that the Examiner intends to reject dependent claims 2 and 4-6 under 35 U.S.C. § 103(a). Accordingly, Applicant respectfully requests that the Examiner clarify which claims have been rejected under 35 U.S.C. § 103(a).

Further, in regard to claims 2 and 4-6, the Examiner acknowledges that HIPPS does not disclose the combination of elements recited therein. Nevertheless, the Examiner asserts that the combination of elements recited

therein (*i.e.*, claims 2 and 4-6) only involve discovering obvious optimum or workable ranges. However, Applicant submits that the Examiner has provided no factual evidence to support his assertion. Further, if the Examiner decides to maintain the aforementioned rejection of claims 2 and 4-6, Applicant respectfully requests that the Examiner provide an appropriate teaching reference indicating the same.

Further, Applicant submits that dependent claims 2 and 4-6, are at least patentable due to their dependency from claim 1 for the reasons noted above. In this regard, Applicant notes that the Examiner has provided no explanation or motivation for correcting the above-noted deficiencies in the teachings of HIPPS. Applicant further submits that the Examiner's assertion that the combination of elements recited in claims 2 and 4-6, only involve discovering obvious optimum or workable ranges, does not provide any teachings which could reasonably be characterized as curing the above-noted deficiencies in the teachings of HIPPS. In this regard, Applicant submits that HIPPS, alone or in any proper combination, does not disclose a tip and body each having two parallel through-holes formed therein in juxtaposition, wherein the body is connected to an outer peripheral longitudinal extending surface of the tip, as recited in amended claim 1.

Further, the Examiner is reminded that "[a] particular parameter must first be recognized as a result-effective variable, *i.e.*, a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In this regard, Applicant submits that

the Examiner has made no such showing. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103 and allow all pending claims in the present application.

In the Official Action, the Examiner has rejected claim 1 of the present application under provisional nonstatutory double patenting as being unpatentable over claim 1 of co-pending Application No. 10/563,913 (Appl. No. '913).

Applicant respectfully traverses the above-noted double patenting rejection. In this regard, Applicant submits that claim 1 of co-pending Appl. No. '913 does not recite the *body being connected to an outer peripheral surface of the tip*. Further, the Examiner has not explained why the aforementioned claims are not patentably distinct from one another. That is, the Examiner has not provided an appropriate secondary teaching reference, or otherwise indicated why at least the above-noted feature is not a patentable distinction. Accordingly, the Examiner is respectfully requested to withdraw the non-statutory double patenting rejection, and allow all pending claims in the present application.

In view of the arguments herein, Applicant submits that independent claim 1 is in condition for allowance. With regard to dependent claims 2-10, Applicant asserts that they are allowable on their own merit, as well as because of their dependency from independent claim 1, which Applicant has shown to be allowable.

Thus, it is respectfully submitted that all of the claims in the present application are clearly patentable over the references cited by the Examiner,

either alone or in combination, and an indication to such effect is respectfully
requested, in due course.

SUMMARY

Applicant submits that the present application is in condition for allowance, and respectfully request an indication to that effect. Accordingly, entry of the present amendments, reconsideration of the outstanding Official Action and allowance of the present application and all the claims therein are respectfully requested and is now believed to be appropriate.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered cosmetic in nature and to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Kensei SHINO et al.

William S. Boshnick
Reg. No. 44,550


Bruce H. Bernstein
Reg. No. 29,027

January 3, 2007
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191